

REMARKS

I. Status of Claims

Claims 1-10 and 12-39 are pending. No claim has been amended herein.

Applicants acknowledge, with appreciation, the Office withdrawing the rejections under 35 U.S.C. § 103(a) over Yuan et al. (U.S. Patent No. 5,685,900) in view of Ginn et al. (U.S. Patent No. 5,454,865) and over Ilmonen et al. (U.S. Patent No. 6,893,536). Also, Applicants acknowledge that claim 36 has been indicated to be allowable if rewritten in independent form. Applicants, however, consider all the claims to be patentable and have therefore not amended the pending claims.

II. Double Patenting Rejections

A. U.S. Published Patent Application No. 2005/0098283 to Golley et al.

The Office provisionally rejected claims 1-3, 6, 7, 12-14, 24-26, and 37-39 on the ground of nonstatutory, obviousness-type, double patenting as allegedly unpatentable over claims 1, 7, 8, 11, 16, 17, 23, 24, 27, 33, 34, 39, and 47 of copending Application No. 10/899,315 (U.S. Published Patent Application No. 2005/0098283 to Golley et al.). Office Action at 3. Applicants respectfully traverse. Applicants note that claims 1, 7, 8, 11, 16, 17, 23, 24, 27, 33, 34, 39, and 47 of Application No. 10/899,315 are no longer pending as evidenced by the Notice of Abandonment issued in that case on June 6, 2006. See Notice of Abandonment attached herewith as Exhibit 1. Accordingly, Applicants respectfully request that the Office withdraw this provisional rejection.

B. U.S. Patent No. 6,808,559 to Golley et al.

The Office also rejected claims 1-3, 6, 7, 12-14, 24-26, and 37-39 on the ground of nonstatutory, obviousness-type, double patenting as allegedly being unpatentable

over claims 1, 7, 8, 11, 16, 17, 23, 24, 27, 33, 34, 39, and 47 of U.S. Patent No. 6,808,559 to Golley et al.. Although Applicants respectfully traverse, Applicants nonetheless submit herewith a Terminal Disclaimer over U.S. Patent No. 6,808,559 to Golley et al., thus mooting this ground for rejection.

III. Rejection under 35 U.S.C. § 102(b)

The Office rejected claims 1-3, 6-10, 12-14, 16-22, 24-29, 31-35, and 37-39 under 35 U.S.C. § 102(b) as allegedly anticipated by Chapman et al. (U.S. Patent No. 4,227,920). Office Action at 4. The Office also rejected claims 1-10, 12-23, and 28-34 under 35 U.S. C. § 102(b) as allegedly being anticipated by Maynard (U.S. Application No. 3,857,781). *Id.* at 6.

The Office recognizes that steepness is not explicitly taught by Chapman et al. and that steepness and particle size distribution are not explicitly taught by Maynard. *Id.* at 5, 7. Nonetheless, the Office concludes that “these [steepness] limitations are considered inherent because there does not appear to be any reason why the cited references would not contain a kaolin with applicants[’] claimed steepness and particle size distribution since the process of making the kaolin as disclosed by Maynard is the same” Office Action at 7. Applicants respectfully traverse.

To establish a case of anticipation based on inherency, the Office must establish that the references necessarily and inevitably would teach the claimed invention. “Inherency . . . may not be established by probabilities or possibilities. The mere fact that a certain thing may result from a given set of circumstances is not sufficient.” *In re Robertson*, 169 F.3d 743, 745, 49 USPQ2d 1949, 1950-51 (Fed. Cir. 1999); M.P.E.P. § 2112(IV). The Office relies on exactly that, the probability or possibility that the kaolins

disclosed in Chapman et al. or Maynard may have a steepness of at least 39. This is insufficient evidence to establish anticipation of claims 1-10 and 12-39 under 35 U.S.C. § 102(b).

Even assuming *arguendo* that the process of making kaolin as disclosed by Chapman et al. or by Maynard is similar to the process described by the present application, the Office incorrectly assumes that the steepness of the kaolin as claimed herein is inherently disclosed in the process of producing the kaolin described by Chapman et al. or by Maynard *Id.* at 5, 7.

The Office overlooks at least one aspect of Chapman et al. and Maynard in its analysis: the starting clays of all thirteen examples disclosed in Chapman et al. are impure kaolin samples from Washington County, Georgia, and likewise the processes of Maynard illustrate the treatment of Georgia crude kaolin clay. See Chapman et al. at column 3, line 42 to column 9, line 10 and Maynard at column 3, lines 7-12. As one of ordinary skill in the art would recognize, the Georgia kaolins of Chapman et al. and Maynard are inherently less steep than the Brazilian Rio Capim kaolins of the examples disclosed in paragraphs [056] to [059] of the Specification. Georgia kaolin is known to be less steep than crude Brazilian kaolin.

The Office incorrectly assumes that the kaolin starting material originating from Washington County, Georgia as disclosed in Chapman et al. and the Georgia crude kaolin clay of Maynard are capable producing a kaolin pigment with a steepness of at least about 39 as does the Brazilian Rio Capim kaolin starting material of the present application. Neither Chapman et al. nor Maynard inherently establish a steepness of at least 39, for at least the reason that the processes disclosed therein start with a less

steep kaolin material than the processes disclosed in the present application; therefore, the processes disclosed by Chapman et al. and Maynard would not necessarily and inevitably arrive at a final product with a steepness of at least about 39, as claimed herein. To the contrary, one skilled in the art would expect the steepness of Chapman et al. and Maynard to be much less, as one would expect different starting materials to yield different products..

Accordingly, neither Chapman et al. nor Maynard inherently anticipate the present claims, and Applicants respectfully request that the Office withdraw its rejection.

IV. Rejections under 35 U.S.C. § 103(a)

The Office rejected claims 1-7, 12-15, 24-26, and 37-39 under 35 U.S.C. § 103(a) as allegedly being obvious over Golley et al. (U.S. Patent No. 6,808,559) and over Golley et al. (U.S. Patent Application Publication No. 2005/0098283). Office Action at 7-11.

Golley et al. (US 2005/0098283) corresponds to Application No. 10/899,315, which is a continuation of Application No. 10/324,019, now U.S. Patent No. 6,808,559. For simplicity, Applicants from this point forward will refer to both references, which contain virtually identical disclosures and claim an identical priority date of February 26, 2002, as Golley.

The Office states that Golley teaches “a kaolin clay pigment having a GE Brightness of at least about 89 and a Steepness of at least about 30, the value of which changes with embodiments to at least about 35, at least about 40, at least about 45 and at least about 50.” Office Action at 8, 10. The Office also alleges that the kaolin of

Golley may have little or 0% titania since both references describe further beneficiation of the kaolin to remove impurities. *Id.* at 10-11.

Despite the Office recognizing that Golley fails to “specifically exemplify a kaolin clay pigment having a steepness of at least 39 and/or a brightness of 93.5 or 94,” as claimed in the pending application, the Office rejected claims 1-7, 12-15, 24-26, and 37-39 as allegedly obvious. The Office contends, without further explanation, that “it would have been obvious to one having ordinary skill in the art that the kaolin clay pigment of Golley et al. would have a steepness of at least 39 and/or a brightness of 93.5 or 94 as claimed by applicants.” *Id.* at 8, 10.

To establish a *prima facie* case of obviousness, the Office must demonstrate that (1) the prior art reference teaches or suggests all of the claim limitations; (2) there exists some suggestion or motivation to modify the reference; and (3) such a modification would result in a reasonable expectation of success. M.P.E.P. § 2143. In the present case, the Office has failed to establish at least that there exists some suggestion or motivation to modify the reference with a reasonable expectation of success.

Rather, the Office admits that the references fails to incorporate a single example encompassing a hydrous kaolin pigment having *both* a GE Brightness of at least about 90.0 *and* a steepness of at least about 39. Nor does the Office point to any teaching or suggestion in the reference that would lead one skilled in the art to make such a hydrous kaolin pigment having all of the claimed properties. Rather, the Office liberally pieced various portions of the disclosure together in an attempt to reconstruct the claimed invention. That kind of shotgun disclosure fails to provide the requisite suggestion for modifying the reference, and certainly fails to meet the high threshold for

establishing a *prima facie* case of obviousness. Indeed, the M.P.E.P. cautions that “[t]he mere fact that references can be . . . modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination.” M.P.E.P. § 2143 (emphasis in original).

Accordingly, no *prima facie* case of obviousness has been established, and Applicants respectfully request withdrawal of the rejection.

V. Conclusion

In view of the foregoing remarks, Applicants respectfully request reconsideration of this application and the timely allowance of the pending claims.

Please grant any extensions of time required to enter this response and charge any additional required fees to our Deposit Account No. 06-0916.

Respectfully submitted,

FINNEGAN, HENDERSON, FARABOW,
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Dated: January 8, 2007

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Attachments: **Exhibit 1:** Notice of Abandonment in U.S. Application No. 10/899,315



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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/899,315	07/27/2004	Christopher R. L. Golley	07810.0113-01	6303
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FINNEGAN, HENDERSON, FARABOW, GARRETT & DUNNER LLP 901 NEW YORK AVENUE, NW WASHINGTON, DC 20001-4413			GREEN, ANTHONY J	
		ART UNIT	PAPER NUMBER	1755

DATE MAILED: 06/06/2006

Please find below and/or attached an Office communication concerning this application or proceeding.



Notice of Abandonment

Application No.	Applicant(s)
10/899,315	GOLLEY ET AL.
Examiner	Art Unit
Anthony J. Green	1755

– The MAILING DATE of this communication appears on the cover sheet with the correspondence address –

This application is abandoned in view of:

1. Applicant's failure to timely file a proper reply to the Office letter mailed on 08 September 2005.
 - (a) A reply was received on _____ (with a Certificate of Mailing or Transmission dated _____), which is after the expiration of the period for reply (including a total extension of time of _____ month(s)) which expired on _____.
 - (b) A proposed reply was received on 12 January 2006, but it does not constitute a proper reply under 37 CFR 1.113 (a) to the final rejection.

(A proper reply under 37 CFR 1.113 to a final rejection consists only of: (1) a timely filed amendment which places the application in condition for allowance; (2) a timely filed Notice of Appeal (with appeal fee); or (3) a timely filed Request for Continued Examination (RCE) in compliance with 37 CFR 1.114).
 - (c) A reply was received on _____ but it does not constitute a proper reply, or a bona fide attempt at a proper reply, to the non-final rejection. See 37 CFR 1.85(a) and 1.111. (See explanation in box 7 below).
 - (d) No reply has been received.

2. Applicant's failure to timely pay the required issue fee and publication fee, if applicable, within the statutory period of three months from the mailing date of the Notice of Allowance (PTOL-85).
 - (a) The issue fee and publication fee, if applicable, was received on _____ (with a Certificate of Mailing or Transmission dated _____), which is after the expiration of the statutory period for payment of the issue fee (and publication fee) set in the Notice of Allowance (PTOL-85).
 - (b) The submitted fee of \$_____ is insufficient. A balance of \$_____ is due.

The issue fee required by 37 CFR 1.18 is \$_____. The publication fee, if required by 37 CFR 1.18(d), is \$_____.
 - (c) The issue fee and publication fee, if applicable, has not been received.

3. Applicant's failure to timely file corrected drawings as required by, and within the three-month period set in, the Notice of Allowability (PTO-37).
 - (a) Proposed corrected drawings were received on _____ (with a Certificate of Mailing or Transmission dated _____), which is after the expiration of the period for reply.
 - (b) No corrected drawings have been received.

4. The letter of express abandonment which is signed by the attorney or agent of record, the assignee of the entire interest, or all of the applicants.

5. The letter of express abandonment which is signed by an attorney or agent (acting in a representative capacity under 37 CFR 1.34(a)) upon the filing of a continuing application.

6. The decision by the Board of Patent Appeals and Interference rendered on _____ and because the period for seeking court review of the decision has expired and there are no allowed claims.

7. The reason(s) below:

Anthony J. Green
Primary Examiner
Art Unit: 1755

Petitions to revive under 37 CFR 1.137(a) or (b), or requests to withdraw the holding of abandonment under 37 CFR 1.181, should be promptly filed to minimize any negative effects on patent term.